REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-16 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, Claims 1 and 3 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of U.S. Patent No. 5,544,289 to Motoyama (hereinafter "the '289 patent") in view of U.S. Patent No. 5,935,262 to Barrett et al. (hereinafter "the '262 patent"); Claims 1-3, 5-7, and 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,282,127 to Mii (hereinafter "the '127 patent") in view of U.S. Patent No. 6,430,711 to Sekizawa (hereinafter "the '711 patent"); and Claims 4, 8, and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '127 and '711 patents, further in view of U.S. Patent No. 5,901,286 to Danknick et al. (hereinafter "the '286 patent").[1]

Claim 1 is directed to a method of monitoring an image handling device communicatively coupled to the Internet, comprising: (1) obtaining, by a first monitoring computer over the Internet, device information of the image handling device, the device information including status information obtained from sensors of the image handling device, and a device identification of the image handling device; (2) storing, by the first monitoring computer, the obtained device information; (3) processing the stored device information by the first monitoring computer to generate a period usage report for the image handling device, wherein the period usage report is based on the status information obtained over a predetermined period of time; (4) transmitting the usage report over the Internet from the first monitoring computer to a second monitoring computer; and (5) receiving the usage report by the second monitoring computer. Further, Claim 1 recites that the first monitoring computer

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[1] Applicants note that the Office Action has not addressed Claim 16, which was added by the previous amendment.

is remote from the image handling device, and that the first monitoring computer is the first computer to obtain the device information from the image handling device.

Applicants respectfully traverse the double patenting rejection of Claims 1 and 3.

Claim 1 of the '289 patent is directed to a method, comprising: (1) storing semi-static state data in a business office device, the semi-static state data including data which may change infrequently over a life of the business office device; (2) initiating communication between the business office device and a computer, by the business office; (3) transmitting the semi-static state data from the business office device to the computer; and (4) receiving the semi-static state data by the computer.

However, Applicants respectfully submit that the '289 Claim 1 fails to recite the steps of obtaining status information from sensors of an image handling device and device identification of an image handling device, as recited in Claim 1. '289 Claim 1 refers only to semi-static data, which includes data which may change infrequently over a life of the business office device. Further, '289 Claim 1 fails to disclose processing the stored device information by the first monitoring device to generate a usage report of the image handling device, wherein the period usage report is based on the status information obtained for a predetermined period of time. Further, '289 Claim 1 fails to recite transmitting the usage report over the Internet from a first monitoring computer to a second monitoring computer, and also fails to disclose that the first monitoring computer is remote from the image handling device and the first monitoring computer is the first computer to obtain the device information from the image handling device, as recited in Claim 1. Finally, '289 Claim 1 fails to recite that the first monitoring computer obtains the device information of the image handling device over the Internet, as recited in Claim 1.

In this regard, Applicants note that in the Response to Arguments section of the outstanding Office Action, the Office Action asserts that Claim 14 of the '289 patent recites

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receiving a model identification and that Claim 15 of the '289 patent recites receiving a serial number of the business office device. However, as discussed above, Applicants respectfully submit that the '289 patent fails to claim obtaining, by a first monitoring computer over the Internet, status information obtained from sensors of the image handling device, as recited in Claim 1.

Applicants respectfully submit that the '262 patent fails to remedy the deficiencies of the '289 patent, as discussed above. In particular, the '262 patent is directed to a network device which interfaces between a local area network and an image forming apparatus. As shown in Figure 1, the '262 patent discloses a printer 102 that has a network expansion device (NED) 1001 directly attached to the printer 102. As shown in Figure 6, the NED includes 8-bit microprocessor 173, flash EPROM 174, and DRAM 175. Further, the '262 patent discloses that the NED 1001 can transfer information about the printer status to a local area network.

However, Applicants respectfully submit that the '262 patent fails to disclose the step of obtaining, by a first monitoring computer over the Internet, device information of the image handling device, the device information including status information obtained from sensors of the image handling device and a device identification of the image handling device. Rather, the '262 patent discloses that the NED is directly attached to the printer. Moreover, Applicants respectfully submit that the '262 patent fails to disclose the communication over the Internet as recited in Claim 1. The '262 patent fails to disclose processing the stored device information by the first monitoring computer to generate a period usage report for the image handling device, wherein the period usage report is based on the status information obtained over a predetermined period of time, as recited in Claim 1. In this regard, Applicants note that pages 7 and 8 of the Office Action state that the '262 patent discloses image handling devices that are configured to transmit electronic images

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over the Internet and that "Barrett's illustrated system does [not] seem to <u>exclude</u> what is defined as the 'Internet' to one of ordinary skill in the art at the time the invention was made."[2] However, Applicants respectfully submit that the '262 patent does not specifically use the term "Internet". Moreover, the Office Action must show that the '262 patent discloses the step of obtaining, by a first monitoring computer over the Internet, device information of the image handling device, as recited in Claim 1, and not merely that the '262 system *does not exclude* the use of the Internet. Moreover, Applicants respectfully submit that the '262 patent does not disclose that the first monitoring computer is remote from the image handling device, the first monitoring computer is the first computer to obtain the device information from the image handling device, and that the first monitoring computer obtains the device information over the Internet, as required by Claim 1.

Accordingly, no matter how the '289 claims and the teachings of the '262 patent are combined, the combination does not teach or suggest all the limitations recited in Claim 1. In particular, the suggested combination does not teach or suggest a first monitoring computer that is remote from an image handling device, wherein the first monitoring computer is the first computer to obtain the device information from the image handling device over the Internet. Further, the combination of the '289 claims and the '262 patent fails to disclose <u>obtaining, by a first monitoring computer over the Internet, device information of the image handling device</u>, and transmitting a usage report over the Internet from the first monitoring computer to a second monitoring computer. Accordingly, for the reasons stated above, Applicants respectfully traverse the obviousness-type double patenting rejection of Claims 1 and 3.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '127 patent discloses everything in Claim 1 with the exception of transmitting

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[2] Office Action, page 8.

information to a second monitoring computer over the Internet, and relies on the '711 patent

to remedy that deficiency.

The '127 patent is directed to a centralized control system for a plurality of terminal

devices (copy machines), comprising information collection means provided in each of the

terminal devices for collecting information of the device status. Further, as shown in Figure

1, the '127 patent discloses that the copy machine transmits the status information to a

communication unit 3, which then communicates the information to the center device 4. As

shown in Figure 1, the '127 patent discloses that the status information is communicated over

a transmission line 5, and a communication line 6, which is a private line "including a public

telephone line, lease line or LAN (local area network)."[3] However, Applicants respectfully

submit that the '127 patent fails to disclose obtaining, by a first monitoring computer over the

Internet, device information of the image handling device, the device information including

status information obtained from sensors of the image handling device and a device

identification of the image handling device, as recited in Claim 1. The '127 patent does not

disclose that such information is obtained by a first monitoring computer over the Internet. In

this regard, in the Response to Arguments section on pages 8 and 9 of the outstanding Office

Action, the Office Action appears to rely on the '711 patent as disclosing this limitation.[4,5]

Accordingly, it appears to Applicants that the Office Action admits that the '127 patent does

not disclose the step of obtaining, by a first monitoring computer over the Internet, device

information of the image handling device. Rather, the Office Action is relying on the '711

patent to disclose that limitation.

The '711 patent is directed to a system and method for monitoring the state of a

plurality of machines connected via a computer network. As shown in Figure 1, the '711

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[3] '127 patent, column 4, lines 47-48.
[4] See page 9 of the outstanding Office Action.
[5] Applicants note that this appears to be in contradiction with the stated rejection of Claim 1 on pages 3 and 4 of the outstanding Office Action.

patent discloses that printers connected in a local area network send status information to an

agent 10, which in turn sends an e-mail to the console unit 20. As noted on page 9 of the

outstanding Office Action, the '711 patent also discloses that:

> In the first-type area 2a, the LAN 3a connects a plurality of
> network printers P, an agent unit 10, and a router 4 to each
> other. The router 4 connects the LAN 3a to a second-type
> computer network 6 set so as to cover a wider area (second-
> type area) 5 than the first-type area 2. In the embodiment, the
> Internet covering almost all the world is adopted as the second-
> type computer network 6. However, every type of computer
> network can be adopted as the second-type computer network 6
> so long as the computer network provides terminal-to-terminal
> information transfer service through electronic mail and
> connects LANs.[6]

Thus, the '711 patent discloses that the printers are connected to a LAN, while the

LAN is connected to the Internet or a similar type of network that connects LANs. However,

Applicants respectfully submit that the '711 patent fails to disclose <u>obtaining, by a first</u>

<u>monitoring computer over the Internet, device information of the image handling device, the</u>

<u>device information including status information obtained from sensors of the image handling</u>

<u>device and a device identification of the image handling device, wherein the first monitoring</u>

<u>computer is remote from the image handling device, and the first monitoring computer is the</u>

<u>first computer to obtain the device information from the image handling device</u>, as recited in

Claim 1. Rather, the '711 patent discloses that the agent units 10 obtain the information from

the printers over a <u>local area network</u>. The above cited passage from columns 18 and 19 of

the '711 patent merely indicates that the second-type network can be the Internet *or an*

equivalent network. However, this passage from the '711 patent, while it may bear on the

transmitting step recited in Claim 1 in which the usage report is transmitted over the Internet

from a first monitoring computer to a second monitoring computer, Applicants respectfully

submit that it is unrelated to the obtaining step recited in Claim 1. The '711 patent discloses

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[6] '711 patent, column 18, line 63 to column 19, line 6.

that the information is obtained from the network printers by a local area network prior to transmission over the Internet.

Thus, no matter how the teachings of the '127 and '711 patents are combined, the combination does not teach or suggest the obtaining step recited in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection of Claim 1 (and all similar rejected dependent claims) should be withdrawn.

Independent Claims 5 and 9 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejections of Claims 5 and 9 (and all similar rejected dependent claims) should be withdrawn.

Regarding the rejection of dependent Claims 4, 8, and 12-15 under 35 U.S.C. § 103, Applicants respectfully submit that the '286 patent fails to remedy the deficiencies of the '127 and '711 patents, as discussed above. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejections of Claims 4, 8, and 12-15 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 5, and 9 (and all associated dependent claims) patentably define over any proper combination of the '127, '711, '262, '289, and '286 patents.

Consequently, in light of the above discussion, the outstanding grounds for rejection

are believed to have been overcome. The present application is believed to be in condition

for formal allowance. An early and favorable action to that effect is respectfully requested.
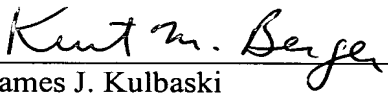
Respectfully submitted,

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